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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,842	06/29/2001	Edward J. Toy	23701-7002	4986

7590 01/26/2005

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EXAMINER	
SHIFERAW, ELENI A	

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/895,842	TOY ET AL.	
	Examiner	Art Unit	
	Eleni A Shiferaw	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/24/02, 7/5/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAIL ACTION

1. Claims 1-21 are presented for examination.

2. Applicant is required to submit the prior arts (Foreign Patent Document, and Other Art) listed on 1449 form in response to this office action.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. .

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 16-17, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Rucklidge et al. (Rucklidge, Patent No.: US 6,449,718 B1).

As per claims 16 and 20, Rucklidge teaches a method/system of producing an electronic file having embedded access control, comprising:

encrypting the electronic file with a first key to produce an encrypted electronic file (Rucklidge Fig. 1 No. 150; the encryptor encrypting the token ID to produce partially encrypted tokenized document); and

associating said encrypted electronic file with an access executable (Rucklidge Col. 2 lines 56-64; associating partial encryption tokenized document with a computer system) and a license server having an access policy (Rucklidge Col. 1 lines 28-33, and col. 2 lines 24-29; limited rights reads on access policy) for the electronic file, both operable on a computing system, said license server responsive to an access request from said access executable to issue a first token to said access executable according to said first key and said access policy (Rucklidge Col. 1 lines 18-23; the information provider/license server responsive to users access request to issue a token), and said access executable responsive to said first token to decrypt said encrypted electronic file into a volatile memory protected by said access executable (Rucklidge Col. 8 lines

1-27 and col. 8 lines 38-43);

As per claim 17 Rucklidge teaches the accessing method/system, wherein encrypting step includes both a cryptological function and a tokenization and transformation function (Rucklidge Col. 7 lines 46-65).

6. Claims 1-10, 12-15, 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris (Patent No.: US 6,718,328 B1) in view of Rucklidge et al. (Rucklidge, Patent No.: US 6,449,718 B1).

As per claims 1 and 19, Norris teaches a method/system of accessing an electronic file, comprising:

querying a license server associated with an encrypted version of the electronic file (Norris Col. 6 lines 54-56) in response to a read access request to the electronic file (Norris Col. 3 lines 24-31);

issuing a token from said license server according to an access policy (Norris Col. 3 lines 33-37; pay-per view reads on access policy) when access to the electronic file is authorized (Norris Col. 4 lines 13-32; content server issuing a token); and

Norris does not explicitly teach decrypting said encrypted version of said electronic file to a volatile memory using said token to produce the electronic file.

However Rucklidge teaches decrypting said encrypted version of said electronic file to a volatile memory using said token to produce the electronic file (Rucklidge Col. 7 lines 46-65, and col. 8 lines 36-43).

Therefore it would have been obvious to one having ordinary skill in the art at time of the invention was made to employs the teachings of Rucklidge within the system of Norris because it would control access to electronic documents and provide secure information through partial encryption of tokenized document.

As per claims 18 and 21, Norris teaches a method/system of providing access to a process executing on a computing system of an encrypted electronic file containing a plain electronic file, comprising:

issuing an access instruction from the process to access the plain electronic file (Norris Col. 1 lines 55-col. 2 lines 7; access instruction (pay-per-view instruction) in the token);

querying a license server associated with the encrypted electronic file in response to said access instruction (Norris col. 1 lines 1-4; requesting electronic document from the network computer by presenting the token (in response to the access instruction)); and

issuing a token from said license server according to an access policy when access to the plain electronic file is authorized, said token containing access authorization instructions (Norris Col. 1 lines 55-65 and Fig. 6 No. 652);

Norris does not explicitly teach:

decrypting so much of the encrypted electronic file to a volatile memory as authorized by said access authorization instructions to write all or a portion of the plain electronic file into said volatile memory; and

providing controlled access of said portion of the plain electronic file in said volatile memory to the process while inhibiting all other accesses to said volatile memory by other processes.

However Rucklidge discloses decrypting so much of the encrypted electronic file (Rucklidge Col. 7 lines 2-27) to a volatile memory as authorized by said access authorization instructions to write all or a portion of the plain electronic file into said volatile memory (Rucklidge Col. 8 lines 36-43); and

providing controlled access of said portion of the plain electronic file in said volatile memory to the process while inhibiting all other accesses to said volatile memory by other processes (Rucklidge Col. 8 lines 1-27).

Therefore it would have been obvious to one havening ordinary skill in the art at the time the invention was made to employ the teachings of Rucklidge within the system of Norris because it would inhibit unauthorized access to electronic document, once decrypted (control unauthorized copies of electronic document, once decrypted by authorized user) (Rucklidge Col. 8 lines 12-27).

As per claim 2 both Norris and Rucklidge teach all the subject matter as described above. In

addition Rucklidge teaches the accessing method/system, further comprising: limiting, after said decrypting step, access by all unauthorized processes to said volatile memory (Rucklidge Col. 2 lines 25-29 and col. 1 lines 45-56). The rational for combining are the same as claim 1 above.

As per claim 3 both Norris and Rucklidge teach all the subject matter as described above. In addition Rucklidge teaches the accessing method/system, further comprising: inhibiting, after said decrypting step, transfer of the electronic file to a nonvolatile memory (Rucklidge Col. 1 lines 45-56 and col. 9 lines 44-49). The rational for combining are the same as claim 1 above.

As per claim 4 both Norris and Rucklidge teach all the subject matter as described above. In addition Rucklidge teaches the accessing method/system, wherein said querying step includes extracting a key from said encrypted version of the electronic file and using said key to access said license server (Rucklidge Col. 7 lines 29-45). The rational for combining are the same as claim 1 above.

As per claim 5 both Norris and Rucklidge teach all the subject matter as described above. In addition Rucklidge teaches the accessing method/system, wherein said access policy limits a number of processes that concurrently access the electronic file in said volatile memory (Rucklidge Col. 2 lines 25-29 and col. 1 lines 45-56). The rational for combining are the same as claim 1 above.

As per claim 6 both Norris and Rucklidge teach all the subject matter as described above. In

addition Rucklidge teaches the accessing method/system, wherein said access policy limits a number of operations on the electronic file in said volatile memory (Rucklidge Col. 2 lines 25-29 and col. 1 lines 45-56). The rational for combining are the same as claim 1 above.

As per claim 7 both Norris and Rucklidge teach all the subject matter as described above. In addition Rucklidge teaches the accessing method/system, wherein said access policy selectively enables decryption of a portion of the electronic file (Rucklidge Col. 7 lines 46-65). The rational for combining are the same as claim 1 above.

As per claim 8 both Norris and Rucklidge teach all the subject matter as described above. In addition Rucklidge teaches the accessing method/system, wherein said decrypting step decrypts a portion of the file at any time and overwrites successive portions on top of previously decrypted portions (Rucklidge Col. 7 lines 46-65). The rational for combining are the same as claim 1 above.

As per claim 9 both Norris and Rucklidge teach all the subject matter as described above. In addition Rucklidge teaches the accessing method/system, wherein decrypting step includes both a cryptological function and a tokenization and transformation function (Rucklidge Col. 7 lines 46-65). The rational for combining are the same as claim 1 above.

As per claim 10 both Norris and Rucklidge teach all the subject matter as described above. In addition Norris teaches the accessing method/system, wherein said read request is issued from an

access program (Norris Col. 8 lines 50-51).

As per claim 12 both Norris and Rucklidge teach all the subject matter as described above. In addition Norris teaches the accessing method/system, wherein said access policy provides for third party access control (Norris Col. 4 lines 58-64).

As per claim 13 both Norris and Rucklidge teach all the subject matter as described above. In addition Norris teaches the accessing method/system, wherein said license server is a local file (Norris Col. 1 lines 46-54).

As per claim 14 both Norris and Rucklidge teach all the subject matter as described above. In addition Norris teaches the accessing method/system, wherein said license server is a remote file not available on a computing system storing the encrypted electronic file (Norris Col. 1 lines 46-54).

As per claim 15 both Norris and Rucklidge teach all the subject matter as described above. In addition Norris teaches the accessing method/system, wherein said license server is coupled to the electronic file (Norris Col. 3 lines 24-27).

7. Claims 16-17, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Rucklidge et al. (Rucklidge, Patent No.: US 6,449,718 B1) and in further view of Ram et al. (Ram, Patent No.: US 6,519,700 B1).

As per claim 11 both Norris and Rucklidge teach all the subject matter as described above.

Norris and Rucklidge do not explicitly disclose an interpreted program translator.

However Ram teaches a system and method for the secure distribution of electronic document in Java programming language (Ram Col. 8 lines 32-37) that reads on the accessing method/system, wherein said access program is an interpreted program translator and the electronic file is source for said interpreted program translator.

Therefore it would have been obvious to one having ordinary skill in the art at time of the invention was made to employs the teachings of Ram within the combination system of Norris and Rucklidge because it would reduce unauthorized reproduction and redistribution or electronic documents by either authorized or unauthorized recipients (Ram Abstract).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AU 2135

Eleni Shiferaw
Art Unit 2136
January 24, 2005